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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,641	07/31/2001	Yuji Shinohara	325772026100	1557

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EXAMINER

POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,641

Applicant(s)

SHINOHARA ET AL.

Examiner

Melvin H Pollack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/5/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: see attached office action.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 12-19 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the particular association between a “destination” email address and the “associated keyword.” The specification does not address this association, nor does it explain, as claim 12 is drawn, how to determine data that “corresponds to the destination,” especially as the specification appears to the examiner to be drawn to adding a database association so that the search engine may determine which keywords were submitted by which users. The claims may, however, be drawn to searching for the e-mail address, searching for the user name and/or domain name, searching for some related user data such as location, etc. For the purposes of this office action only, the examiner will assume that the applicant means a database association of some type and possibly to keep track of a history of searches for a particular user.

Claim Rejections - 35 USC § 102

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 11-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Salam et al. (6,594,654).

6. For claim 1, Salam teaches a data processing (col. 1, line 1 – col. 7, line 42) method (abstract) comprising:

- a. A keyword accepting step (Fig. 14, #1401) for accepting a keyword (col. 5, lines 35-40);
- b. A document file accepting step (Fig. 1, #12) for accepting a document file (col. 5, lines 45-50; col. 6, lines 13-20);
- c. A data extracting step (col. 14, lines 20-30) for extracting data corresponding to the keyword, from the document file (col. 15, lines 8-20); and
- d. A data attaching step for attaching the extracted data to an e-mail message (col. 9, line 65 – col. 10, line 15; col. 15, lines 27-31).

7. The examiner notes that further proof is located (col. 8, line 45 – col. 11, line 15; col. 13, line 13 – col. 15, line 38) within the art.

8. For claim 2, Salam teaches that the data corresponding to the keyword is data that includes the keyword (col. 15, lines 5-20).

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9. For claim 11, Salam teaches that the e-mail message is an HTML-format message (Fig. 20, #2003).

10. Claims 12-14 are drawn to the limitations in claim 1. Salam also teaches the added limitations of accepting a destination (Fig. 13) and extracting data corresponding (not necessarily meaning including, see 112 rejection above) to the destination (col. 8, line 65 – col. 9, line 5). Therefore, since claim 1 is rejected, claims 12-14 are also rejected for the reasons above.

11. Claims 15 and 16 are drawn to the limitations in claims 1 and 12. Therefore, since claims 1 and 12 are rejected, claims 15 and 16 are also rejected for the reasons above.

12. Claim 17 is drawn to the limitations in claim 15. Salam also teaches the added limitations of accepting, and choosing from, a plurality of destinations (col. 22, lines 60-65). Therefore, since claim 15 is rejected, claim 17 is also rejected for the reasons above.

13. Claim 18 is drawn to a software system that implements the method drawn in claim 1. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claim 1 is rejected, claim 18 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

14. Claim 19 is drawn to a hardware system that implements the method drawn in claim 1. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claim 1 is rejected, claim 19 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salam as applied to claim 1 above, and further in view of Christensen et al. (6,347,320).

17. For claim 3, Salam does not expressly disclose that the data corresponding to the keyword is a paragraph. Salam does teach that the amount of data may be selected. Christensen teaches a method (abstract) of searching HTML files (col. 1, line 1 – col. 4, line 16), in which the included text may be between any two tags (col. 6, line 63 – col. 8, line 25) including within text paragraphs (Fig. 5). At the time the invention was made, one of ordinary skill in the art would have used Christensen's HTML-tag method to limit results to more relevant files (col. 3, lines 44-47).

18. For claim 4, Salam teaches that the document is an HTML file (col. 9, lines 20-35), but does not expressly disclose that extracting the paragraph is data that begins after a paragraph start tag and ends before a paragraph end tag. Christensen teaches this limitation (col. 7, lines 1-15). At the time the invention was made, one of ordinary skill in the art would have used Christensen's HTML-tag method to limit results to more relevant files (col. 3, lines 44-47).

19. For claim 5, Salam does not expressly disclose that the data corresponding to the keyword is a row corresponding to the keyword from a table included in the document file. Christensen teaches this limitation (col. 8, lines 8-12). At the time the invention was made, one of ordinary skill in the art would have used Christensen's table method in Salam to limit results to more relevant files (col. 3, lines 44-47).

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20. For claim 6, Salam does not expressly disclose that the document is an HTML file, and the row is data that begins after a table row start tag and ends before a table row end tag.

Christensen teaches this limitation (col. 7, lines 1-15). At the time the invention was made, one of ordinary skill in the art would have used Christensen's HTML-tag method to limit results to more relevant files (col. 3, lines 44-47).

21. For claim 7, Salam does not expressly disclose that the data corresponding to the keyword is a column corresponding to the keyword from a table included in the document file. Christensen teaches this limitation (col. 8, lines 8-12). At the time the invention was made, one of ordinary skill in the art would have used Christensen's table method in Salam to limit results to more relevant files (col. 3, lines 44-47).

22. For claim 8, Salam does not expressly disclose that the document is an HTML file, and the column is made up of one or more sets of data that begin after a table data cell start tag and end before a table data cell end tag. Christensen teaches this limitation (col. 7, lines 1-15). At the time the invention was made, one of ordinary skill in the art would have used Christensen's HTML-tag method to limit results to more relevant files (col. 3, lines 44-47).

23. For claim 9, Salam does not expressly disclose that the data corresponding to the keyword is a cell corresponding to the keyword from a table included in the document file. Christensen teaches this limitation (col. 8, lines 8-12). At the time the invention was made, one of ordinary skill in the art would have used Christensen's table method in Salam to limit results to more relevant files (col. 3, lines 44-47).

24. For claim 10, Salam teaches that the document is an HTML file, and the cell is data that begins after a table data cell start tag and ends before a table data cell end tag. Christensen

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teaches this limitation (col. 7, lines 1-15). At the time the invention was made, one of ordinary skill in the art would have used Christensen's HTML-tag method to limit results to more relevant files (col. 3, lines 44-47).

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP
10 December 2004

Beth J. Smith
Patent Examiner
12/13/04